

**REMARKS**

Claims 1-11 are rejected in the Action under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of Takahashi et al. (U.S. Patent No. 6,652,979) ("Takahashi"). A terminal disclaimer under 37 C.F.R. § 1.321(c) is submitted herewith to overcome this rejection.

Claims 1-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Asai et al. (U.S. Patent No. 5,780,158) ("Asai") in view of Kawakami et al. (U.S. Patent No. 4,590,119) ("Kawakami").

Asai is cited as disclosing a multilayer polyester film suitable for laminating to metal substrates for food packaging applications, where the film comprises a layer of an ethylene-terephthalate polyester having certain specified properties and which is produced using a germanium catalyst and optionally contains particles and "additives" (citing lines 48-54 of Col. 5). Kawakami is cited as disclosing the addition of lubricating agents such as carnauba wax into polyester films to improve slip and film handling properties. The position of the Office is that it would have been obvious to one of ordinary skill in the art to incorporate a conventional slip additive in the film of Asai in order to improve film and release properties during packaging and container forming operations.

Reconsideration and removal of the 35 U.S.C. § 103(a) rejection are respectfully requested. For the reasons explained below, the art fails to provide a proper motive to a person of ordinary skill in the art to modify the polyester film of Asai as proposed in the Action.

The Office has combined isolated disclosures in Asai and Kawakami as supporting a suggestion or motive for the art-skilled person to add certain agents disclosed in Kawakami to the polyester of the film of Asai "in order to improve film and laminate handling during packaging and container forming operations." However, the Office has not provided evidence showing that the disclosures of the Asai and Kawakami references would have suggested to the art-skilled person that the addition of the specific additives disclosed in Kawakami will improve film and laminate handling during packaging and container forming operations using the film of Asai.

Asai, which is directed to a film to be laminated on a metal can, discloses nothing concerning additives to improve film and laminate handling during packaging and container forming operations. The additives described in Col. 6, lines 48-54, of Asai are antioxidants, heat stabilizers, ultraviolet light absorbers, plasticizers, inorganic particles, organic particles, and antistatic agents. The Office has not provided any reasons why

these additives would be expected to be understood by the person in the art to be related to the fabricating properties of the film disclosed therein.

Kawakami, which is directed to a film for a substrate of a magnetic recording medium, discloses additives for improving slipperiness for good head contact and running property of a polyester film for a magnetic recording medium. The Office has not explained why an additive for providing slipperiness for good head contact and running property of a polyester film for a magnetic recording medium would be expected to improve film and laminate handling during packaging and container forming operations and other properties (such as non-stick property) of the film disclosed in Asai to be laminated on a metal and subjected to can making processing.

The disclosures of Asai and Kawakami cannot be considered in the abstract. They must be viewed in the context of the teachings of the entire references.

Further, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected the components for combination in the manner claimed. See *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The Office has not provided such particular findings.

Moreover, the data of the 132 declaration of Ryosuke Matsui submitted in the parent application show that the addition of wax to the polyester will not necessarily produce good processability. These data rebut the position of the Office that a person of ordinary skill in the art would have been motivated to add the wax of Kawakami to the film of Asai to improve film and laminate handling.

For these reasons, the Office has not properly supported a case of prima facie obviousness of the claims of the present application.

Applicants also note that although Kawakami discloses carnauba wax, the addition of the wax is aimed at improving slipperiness (i.e., a frictional property), not at improving a non-stick property as required for a film to be laminated on a metal can. Slipperiness and non-stick properties are essentially different properties. In the present invention, the addition of wax modulates the angle of contact to water and the surface free energy and achieves a good non-stick property. Asai discloses nothing about angle of contact to water or the surface free energy. Kawakami also does not disclose that addition of carnauba wax to the polyester film for a magnetic recording medium disclosed therein modulates the angle of contact to water and the surface free energy and achieves a good non-stick property. These facts

show that the combination of Asai and Kawakami will not support prima facie obviousness.

Applicants also respectfully submit that a person of ordinary skill in the art would not have been motivated to combine the disclosures of Asai and Kawakami. Asai discloses a film to be laminated on a metal can. On the other hand, Kawakami discloses a film for a substrate of a magnetic recording medium. These two films are absolutely different in terms of required mechanical properties, for example, Young's modulus and elongation.

For a film to be laminated on a metal can, high elongation and low Young's modulus are generally required for fabrication. On the other hand, as a film for a substrate of a magnetic recording medium, a high Young's modulus and low elongation are generally required, as described, for example, in U.S. Patent Nos. 5,556,691; 5,374,467; and 4,720,412, copies of which are submitted herewith.

References which conflict with each other with respect to required properties of the inventions disclosed therein cannot be properly combined with each other.

For this reason also, the 35 U.S.C. § 103(a) rejection is not proper and should be removed..

The foregoing is believed to be a complete and proper response to the Office Action dated March 16, 2005, and is believed to place this application in condition for allowance.. If, however, minor

PATENT APPLN. NO. 10/648,320  
RESPONSE UNDER 37 C.F.R. §1.111

**PATENT  
NON-FINAL**

issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicant(s) hereby petition(s) for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

The fee for the terminal disclaimer may also be charged to Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

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Attachments: Terminal Disclaimer under 37 C.F.R. §1.321(c)

U.S. Patent Nos. 5,556,691; 5,374,467; and  
4,720,412